

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed July 6, 2004 (i.e., Paper No. 28). Having addressed all objections and grounds of rejection, originally presented claims 1-20, along with newly presented claims 21-25, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

The Examiner has rejected claims 1-4, 6-14, and 16-18 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,070,150, issued to Remington et al (hereinafter referred to as "Remington"). This ground of rejection is respectfully traversed as to the amended claims for the following reasons.

The standard for a finding of anticipation is stated in MPEP 2131, which reads in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In other words, the Examiner must find every claim element either expressly or inherently within the prior art reference (i.e.,

Remington).

Claim 1, for example, has seven (7) separate and individual claim elements. The Examiner has apparently been unable to find any of these seven claim elements expressly disclosed within Remington. Instead he has surprisingly found all seven claim elements to be "inherently" disclosed by Remington, without making the evidentiary showings required by MPEP 2112, which provides in part:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). (Emphasis added)

The Examiner simply has not met his burden under MPEP 2112. Therefore, the rejection is respectfully traversed as a matter of law.

Specifically, the first element of claim 1 is a "user terminal which generates a log-on service request". Admitting that

Remington does not meet this limitation, the Examiner states:

....a disclosure that inherently includes some form of user authentication.... (emphasis added)

This statement is both clearly erroneous and inadequate as a matter of law. It is clearly erroneous, because it is possible to have alternatives including, no security provisions for access (see specification at page 5, lines 4-5; rely upon physical security (see specification at page 5, lines 8-9; etc. As a result, the Examiner has not met the requirement of MPEP 2112, "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference".

Even if the Examiner's statement were not clearly erroneous, it is inadequate as a matter of law. His finding of "some form of user authentication" simply does not meet the "element as set forth in the claim" as required by MPEP 2131.

Similarly, the second element of claim 1 is "a data base management system". Again, the Examiner admits that Remington does not have this element. Instead he apparently alleges that "Biller 112" of Remington is "a teaching which renders the existence of a database management system inherent in the system". And again, this statement is both clearly erroneous and inadequate as a matter of law.

Webopedia, the on-line dictionary of data processing

terminology, defines "data base management system as":

A collection of programs that enables [a user] to store, modify, and extract information from a database.

Clearly Remington does not disclose a "data base management system" in accordance with this definition. It does not enable a user to interact with a data base in this fashion (i.e., store, modify, and extract). Whereas it may be possible to implement "Biller 112" using a particular type of data base management system, these necessary functions needed to meet the definition of "data base management system" have nothing to do with Remington, and therefore, do not need to be present of necessity as required by MPEP 2131.

The third element of claim 1 is "a software controlled server" having certain characteristics. The Examiner again reads this limitation onto "Biller 112", which itself is an error as a matter of law. Claim 1 requires both a "data base management system" and a separate and independent "software controlled server".

Furthermore, the Examiner again finds the characteristics of this third element to be "inherent" stating:

....a disclosure that inherently includes some form of user authentication (emphasis added)

As explained above, this finding is both clearly erroneous (i.e., other security approaches) and inadequate as a matter of law (i.e., does not address the claim limitation).

The fourth element of claim 1 is an "administration module" having certain characteristics. Again, the Examiner admits that Remington does not have this element. Instead, he cites numerous portions of Remington, none of which having anything to do with the claimed "administration module". He then concludes:

....disclosures that inherently include the generation of the claimed reports on a particular date, such as on the 15th of each month.

When viewed in accordance with the requirements of MPEP 2131 and MPEP 2112, this conclusion is just silly. Many bills are presented aperiodically (e.g., related to total account balance), many bills are presented upon being incurred (e.g., in a restaurant, hotel, supermarket, taxi cab, etc.); many bills are only presented upon request; etc. The Examiner admits that Remington does not meet the limitation of claim 1 and fails to support his rejection in accordance with controlling law.

The fifth element is a "software object" having certain characteristics. Again, the Examiner reads this limitation onto Remington's "Biller 112" in contravention of controlling law. And again, admitting that Remington still does not meet the characteristics of the claim element, the Examiner states:

....disclosures that inherently include the generation of the claimed reports on a particular date, such as on the 15th of each month.

Thus, the Examiner attempts to build his finding of the fifth element of claim 1 upon the clearly erroneous and legally incorrect

findings with regard to element four of claim 1.

The sixth element of claim 1 is a "storage facility" having certain characteristics. As the Remington does not expressly disclose this element, it is assumed that the Examiner means to find inherency, even though he does not explicitly say so.

The seventh element of claim 1 is a "delivery facility" having certain characteristics. Again, the Examiner appears to read this limitation onto "Biller 112" and again he finds the characteristics of this element to be inherent.

Thus, claim 1 has seven (7) separate and distinct claim elements. The Examiner has admitted that not one of these seven elements is expressly disclosed by Remington. He has found all seven claim elements to be inherent using clearly erroneous findings of fact and without meeting his burden established by MPEP 2112. Therefore, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings of fact and improper application of controlling law.

Claim 6 is an independent apparatus claim having five elements. Because Applicants chose to claim the "publicly accessible digital communications network" as a separate element, the Examiner has been able to find one element of claim 6 expressly disclosed within Remington. Nevertheless, the Examiner repeats his clearly erroneous findings of fact and errors of law in finding the

remaining four claim elements inherently disclosed by Remington as discussed above. The rejection of claim 6, and all claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings of fact and errors of law.

Claim 11 is an independent method claim having five separate and independent steps. Using the clearly erroneous findings of fact and errors of law discussed above, the Examiner finds three of the five steps (i.e., steps a, d, and e) to be inherently disclosed by Remington. In clearly erroneously finding step b, the Examiner states:

converting said report into a display page (see discussion of the use of HTML in generating bills, col. 12, lines 24-60);

The finding is also legally irrelevant in that the claim requires "converting said report into a display page". Even if Remington disclosed "the use of HTML in generating bills", which it does not, Remington would not have expressly disclosed the claimed element.

Claim 11, element d, is limited to a "spooling" step. The Examiner again cites extensive portions of Remington which have nothing to do with the claimed element.

The rejection of claim 11, and all claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings of fact and errors of law.

Claim 16 is an independent apparatus claim having five "means-plus-function" limitations. As with the rejection of claim 6, the

Examiner has utilized clearly erroneous findings of law and improper application of controlling law in finding four of these five "means-plus-function" limitations to be inherently disclosed by Remington. The rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and is further limited by a plurality of user terminals whereby the same report is delivered to each of these plurality of user terminals upon log-on. In making his rejection, the Examiner cites extensive portions of Remington and makes a number of arguments which do not make any sense. Though Remington shows only one consumer (i.e., Consumer 111), if it did have a plurality of "consumers" it is inconceivable that the system would send the exact same bill to each. Furthermore, this contradicts the Examiner's assertion that Remington inherently contains a "user authentication" feature. The rejection of claim 2, and claims depending therefrom, is respectfully traversed.

Claim 4 depends from claim 3 and further limits the "storage facility". In his rejection of claim 1, the Examiner admits that Remington does not expressly disclose the claimed "storage facility". In his rejection of claim 4, the Examiner disregards the requirement of MPEP 2131 that all elements must be expressly or inherently disclosed. Instead, without showing any authority, the Examiner finds the disclosure of Remington to be "analogous". MPEP 2131 requires "expressly" or "inherently". It does not provide for

"analogous". The rejection of claim 4, and any claim depending therefrom is respectfully traversed for failure to comply with controlling law.

In rejecting claim 7, the Examiner repeats the errors associated with his rejection of claim 2. There is no showing that Remington sends or should send the exact same bill to more than one consumer. The rejection of claim 7 is respectfully traversed.

Claim 8 depends from claim 7 and is further limited by a repository for storing the report for later delivery. Of course, Remington neither expressly nor inherently discloses this feature. Therefore, the Examiner again departs from controlling law by finding another "analogous" situation. The rejection of claim 8 is respectfully traversed for failure to comply with controlling law.

In rejecting claim 13, the Examiner states:

Regarding claim 13, Remington et al. additionally teaches a method further comprising a plurality of user terminals (see disclosure that prior art systems distributed bills to a plurality of customers, col. 1 line 64 through col. 2, line 44; see also disclosure that the bill is transmitted to a plurality of users, col. 16, lines 14-42, and particularly lines 36-38). (emphasis added)

Remington column 1, line 64, through column 2, line 44, says nothing of even one "user terminal", much less the claimed "plurality of user terminals". The citation actually discusses prior art manual systems having no "user terminals".

Column 16, lines 14-42, discusses Fig. 11 which shows only one "Consumer 114". Furthermore, there is certainly no suggestion that

Remington could or would or should deliver the same report to a plurality of user terminals, even if it had a plurality of user terminals. The rejection of claim 13, and claims depending therefrom, is respectfully traversed.

Claim 18 depends from claim 17 which further limits the "generating means". Again, the Examiner cannot find the claim limitations either "expressly" or "inherently" as required by MPEP 2131. Therefore, the Examiner finds another "analogy" which is not supported by controlling law. Therefore, even if the Examiner's finding were not clearly erroneous factually, it is legally irrelevant as not complying with MPEP 2131. The rejection of claim 18, and claims depending therefrom, is respectfully traversed.

The Examiner has rejected claims 5, 15, and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Remington in view of "Unisys CSG MarketPlace-The Mapper System" (hereinafter referred to as "Unisys"). It has been previously pointed out to the Examiner that Applicant's Background of the Invention specifically explains why the alleged combination would not be motivated. In response thereto, the Examiner states:

It would have been obvious to one of ordinary skill at the time of the invention to incorporate the CLASSIC MAPPER database management system, since (sic) MAPPER provides information access, analysis and reporting in an open enterprise-wide client/server environment.... (emphasis added)

The reference cited by the Examiner explicitly limits its scope to an enterprise-wide environment. It specifically disclaims access

in the claimed publicly accessible digital data communication network environment. The rejection of claims 5, 15, and 19-20 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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